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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,603	02/28/2002	Kyoko Kobayashi	0992-0128P	3606

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EXAMINER	
VO, HAI	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/069,603	KOBAYASHI ET AL.
	Examiner	Art Unit
	Hai Vo	1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *4-19 and 42-46* is/are allowed.

6)☒ Claim(s) *2,3 and 20-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 2 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 974 617 in view of Bordner et al (US 3,624,964). EP'617 teaches a laminate for use in glass run channels comprising a core and a skin member being bonded to the core. EP'617 teaches the skin member comprising an olefin thermoplastic elastomer and at least one kind of lubricant recited by the claims. EP'617 teaches the core being an olefin thermoplastic elastomer. EP'617 is silent as to the core being a foamed body of the olefin thermoplastic elastomer. Bordner, however, teaches a glass run channel comprising a foam core and outer skin member. Bordner also teaches the use of the foam core to cause the outer skin to snuggly hug and fit against the adjacent bearing surfaces of the window to thereby provide an effective thermal barrier (column 1, lines 53-59), which is important to the expectation of successfully practicing of the invention of EP'617 and thus suggesting the modification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to foam the core of the glass run channel of EP'617 motivated by the desire to cause the outer skin to snuggly hug and fit against the adjacent bearing surfaces of the window to thereby provide an effective thermal barrier.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 974 617 in view of Bordner et al (US 3,624,964) as applied to claim 2 above, further in view of Yoshida et al (US 6,500,561). EP'617 does not specifically disclose a compression set and a melt flow rate of the olefinic thermoplastic elastomer of the core. Therefore, it is necessary and thus obvious for the skilled artisan to look to the prior art for the suitable compression set and melt flow rate of the olefinic thermoplastic elastomer of the core. Yoshida teaches a glass run channel comprising the olefinic thermoplatic elastomer having a melt flow rate meeting the specific range required by the claim (column 3, lines 25-26). It appears that Yoshida is using the same elastomer as Applicants and the elastomer having the melt flow rate within the claimed range. It is the examiner's position that the compression set of the olefinic thermoplastic elastomer of the core would be inherently present. This is in line with ***In re Spada***, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. In the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the olefinic thermoplastic elastomer of the core having a melt flow rate within the range instantly claimed, motivated by the desire to balance the mechanical strength and processing properties of the core, which is important to expectation of successfully practicing the invention of EP'617, thus further suggesting the modification.
4. Claims 20-40, and 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 974 617 in view of Yorita et al (US 6,303,666). EP'617 teaches a laminate

for use in glass run channels comprising a core and a skin member being bonded to the core. EP'617 teaches the skin member made of an ultrahigh molecular weight polyolefin having an intrinsic viscosity within the claimed range [0103]. EP'617 also teaches the skin member comprising an olefin thermoplastic elastomer and at least one kind of lubricant recited by the claims (abstract). EP'617 also teaches the olefin thermoplastic elastomer used in the skin layer comprising a mixture of the crystalline polyolefin resin and the rubber to a dynamic heat treatment [0071] in the presence of a cross-linking agent (abstract). EP'617 teaches the core being an olefin thermoplastic elastomer. EP'617 is silent as to the core being a foamed body of the olefin thermoplastic elastomer. Yorita, however, teaches a production of expanded olefinic thermoplastic elastomer for use in weather strip sponges. Yorita teaches the weather strip sponge comprising a foamed body made of a thermoplatic elastomer (A) and the olefinic plastic (B) in proportions of from 90-99 parts by weight and 1 to 10 parts by weight respectively (column 13, lines 5-15). Yorita teaches the thermoplastic elastomer (A) having the composition as required by the claims (column 7, lines 60-65). Yorita teaches the olefinic plastic (B) having an olefin content of 50-100 mole % and a melt flow rate of 0,01 to 2 g/10min. Yorita teaches the olefinic plastic (B) being a propylene/alpha-olefin copolymer (column 12, lines 44-46). Yorita teaches the expanded olefinic thermoplastic elastomer product comprising 0.1 to 20 parts by weight of the thermoplastic elastomer (column 14, lines 30-31). Table 1 of Yorita shows that the expanded olefinic thermoplastic elastomer product having the foaming expansion ratio of two fold. Yorita teaches the

expanded olefinic thermoplastic elastomer products excellent in flexibility, heat resistance, which is important to expectation of successfully practicing the invention of EP'617, thus further suggesting the modification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the core of EP'617 by expanded olefinic thermoplastic elastomer product as taught in Yorita motivated by the desire to provide the glass run channel excellent in flexibility, and heat reisistance.

Yorita teaches the expanded olefinic thermoplastic elastomer comprising 5 to 100 parts by weight of a softening agent per 100 parts by weight of the thermoplatic elastomer to make it possible to sufficiently improve the flowability of the thermoplastic elastomer without reducing the heat resistance and tensile characteristics of an expanded product (column 9, lines 65-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the softening agent in the core of EP'617 as modified by Yorita motivated by the desire to sufficiently improve the flowability of the thermoplastic elastomer without reducing the heat resistance and tensile characteristics of the core.

Yorita teaches the thermoplatic elastomer (A) comprising a decomposable olefin plastic (b) having a melt flow rate of 0.5 to 80 g/10min within the claimed range to improve the flowability and heat resistance of the core (column 9, lines 1-10). It appears that Yorita is using the same olefin plastic as Applicants and the olefin plastic having the melt flow rate within the claimed range. It is the examiner's

position that the compression set of the olefin plastic of the core would be inherently present. This is in line with ***In re Spada***, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. In the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the olefin plastic of the core having a melt flow rate within the range instantly claimed, motivated by the desire to improve the flowability and heat resistance of the core which is important to expectation of successfully practicing the invention of EP'617, thus further suggesting the modification.

Allowable Subject Matter

5. Claims 4-19, and 42-46 are allowed. None of the prior art teaches or suggests a composition of the olefinic thermoplastic elastomer comprising 5 –60 parts by weight of a polyethylene resin and 40-95 parts by weight of a copolymer based on ethylene/alpha-olefin having a Mooney viscosity ML $_{1+4}$ (100°C) of 90-250 and an ethylene content of 70-95 mole %.

Response to Amendment

6. The claim objections have been overcome by the present amendement.
7. The 102/103 art rejections over EP 0 360 577 have been overcome by the present amendment and cancellation of claim 1.
8. The double patenting rejections and the art rejections over EP 0 360 577 in view of EP 0 974 617 have been overcome by the present arguments. Applicant's

arguments with respect to claims 2, 3, 20-40 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0994.

Hai Vo
TC 1700

HV